

REMARKS

Entry of this Amendment and reconsideration are respectfully requested in view of the amendments made to the claims and for the remarks made herein.

Claims 1-10 are pending and stand rejected.

Claims 1, 7 and 9 are independent claims.

Claims 1, 7 and 9 have been amended.

Claims 1-4 and 6-9 stand rejected under 35 USC 103(a) as being unpatentable over Abe (USP no. 6, 381, 208) in view of Gurer (USP no. 6,177,133). Claims 5 and 10 stand rejected under 35 USC 103(a) as being unpatentable over Abe and Gurer in view of Tsukagoshi (USPPA 2002/0018438).

Claims 1-4 and 6-9 stand rejected under 35 USC 103(a) as being unpatentable over Abe in view of Gurer. In support of the rejection of the claims, the Office Action asserts that Abe discloses the elements of the claims but fails to disclose the thickness variation profile being determined based on a given lacquer formulation of the transparent layer and a rotational speed in creation of the transparent layer. The Office Action refers to Gurer for disclosing this element of the claims.

Applicant respectfully disagrees with and explicitly traverses the reason for rejecting the claims. However, in order to advance the prosecution of this matter, applicant has elected to amend the independent claims to further recite the thickness profile being determined based on a specific lacquer formulation of the transparent layer and a rotational speed used in the formation of the transparent layer in advance and being stamped onto the optical carrier during manufacture. No new matter has been added. Support for the amendment may be found at least on page 7, lines 14-16 ("a thickness profile – that is to say, the way in which the thickness of the transparent layer 2 at least coarsely varies with radial location – is characterized in advance of its manufacture. This information is

stamped onto the lead-in zone of the optical disc 1 at the time of manufacture.").

Abe discloses a system wherein information regarding a transparent layer is contained in two areas. The first area includes an average thickness value and the second area includes information corresponding to a local thickness value at respective points within the transparent layer. The local thickness values, which may be deviations from the average thickness value, are determined after the disk is manufactured and written into a writeable area. The local thickness values are combined with the average value to determine a thickness values at a corresponding location.

In col. 4, lines 55-65, Abe discloses that the local values are obtained after manufacturing. In describing the replacement of the average thickness with the thickness of the transmitting layer at a plurality of arbitrary positions, Abe fails to provide any specific discussion of how the plurality of thickness values may be written in place of the average value.

From the teaching of Abe with regard to using an average value and the local values, one skilled in the art would understand that the plurality of thickness values used to replace the average value, are obtained after the manufacture of the disk as the plurality of thickness values may be obtained from inspection of the created disk. The thickness values would then be used in place of the average thickness value, such that intermediate thickness values at different positions may be obtained or determined with reference to the thickness value closest to the intermediate thickness value, for example.

Gurer discloses a spin coating process for controlling the mean thickness of a photo-resist on the surface of a semiconductor wafer. The process comprises the steps of applying the solution to the wafer surface and spinning the wafer about a central axis at a spindle speed until the solution has dried. The spindle speed is a function of the desired means thickness of the photo-resist,

the barometric pressure and the relative humidity. The spindle speed is determined from a statistical model described by a known equation.

Gurer discloses in col. 5, lines 17-67, the process of adjusting the spindle speed to achieve a desired thickness.

However, even if the teachings of Gurer were combined with the teaching of Abe, nowhere does either reference provide any teaching regarding characterizing the variation in advance and stamp the variation onto the relief structure at a time of manufacture of the optical record carrier, as is recited in the claims.

Rather, the combination of Abe and Gurer would create a device that would spin coat a material onto the optical carrier to achieve a desired thickness in accordance with Equation 3 and then perform measurements to determine variations of the thickness of the material at selected areas. The measured the variations may then be stored in a local area, after manufacture of the disk.

A claimed invention is *prima facie* obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings therein. Second, there must be a reasonable expectation of success. And, third, the prior art reference or combined references must teach or suggest all the claim limitations. However, the Court in *KSR v. Teleflex* (citation omitted) has held that the teaching, suggestion and motivation test (TSM) is merely to be used as a helpful hint in determining obviousness and a bright light application of such a test is adverse to those factors for determining obviousness enumerated in the *Graham v. John Deere* (i.e., the scope and content of the prior art, the level of ordinary skill in the art, the differences between the claimed invention and the prior art and objective indicia of non-obviousness) (citation omitted).

In this case, the combination of Abe and Gurer fails to teach at least one element recited in the claims and neither reference provides any motivation to store variation data onto the disc during the manufacturing process, as is recited in the claims.

Accordingly, the combination of Abe and Gurer cannot be said to render obvious the invention claimed in each of the independent claims, as the combination of Abe and Gurer fails to disclose a material element recited in the claims.

For the amendments made to the claims and for the remarks made herein, applicant submits that the rejection of the independent claims, and the claims dependent therefrom, has been overcome.

Claims 5 and 10 stand rejected under 35 USC 103(a) as being unpatentable over Abe, Gruer in view of Tsukagoshi (USPPA 2002/0018438).

Applicant respectfully disagrees with and explicitly traverses the rejection of the claims. Claims 5 and 10 depend from independent claims 1 and 9, respectively, which have been shown to include subject matter not disclosed by the combination of Abe and Gurer. Tsukagoshi fails to provide any teaching to correct the deficiency found to exist in Abe and Gurer.

Hence, the combination of Abe, Gurer and Tsukagoshi fails to disclose a material element recited in the independent claims, and consequentially, in the aforementioned dependent claims.

Applicant submits that the rejection of the subject matter recited in claims 5 and 10 has been overcome.

For the amendments made to the claims and for the remarks made herein, applicant submits that all the objections and rejections have been overcome and that the claims are in a condition for allowance. Withdrawal of the rejections of the claims and the issuance of a Notice of Allowance is respectfully requested.

Applicant denies any statement, position or averment stated in the Office Action that is not specifically addressed by the foregoing. Any rejection and/or points of argument not addressed are moot in view of the presented arguments and no arguments are waived and none of the statements and/or assertions made in the Office Action is conceded.

Applicant makes no statement regarding the patentability of the subject matter recited in the claims prior to this Amendment and has amended the claims solely to facilitate expeditious prosecution of this patent application. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by the originally filed claims, as presented prior to this Amendment, and any additional claims in one or more continuing applications during the pendency of the instant application.

Should the Examiner believe that the disposition of any issues arising from this response may be best resolved by a telephone call, the Examiner is invited to contact applicant's representative at the telephone number listed below.

Respectfully submitted,
Michael E. Belk, Reg. No. 33357

Date: November 4, 2009

/Carl A. Giordano/

By: Carl A. Giordano
Attorney for Applicant
Registration No. 41,780

Mail all correspondence to:

Michael E. Belk, Esq.
US PHILIPS CORPORATION
P.O. Box 3001
Briarcliff Manor, NY 10510-8001
Phone: (914) 333-9643
Fax: (914) 332-0615

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

The undersigned hereby certifies that this document is being
[] Transmitted by facsimile to 571 273 8300;
[] Placed with the US Postal Service with First Class postage attached to the address indicated above;
on November _____ 2009

Print Name

Signature